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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,848	02/20/2004	Jef De Brabander	AP35699 090495.0282	7487
22428	7590	01/10/2006	EXAMINER	
FOLEY AND LARDNER LLP			OWENS, AMELIA A	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1625	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,848

Applicant(s)

DE BRABANDER ET AL.

Examiner

Amelia A. Owens

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-27 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,13-17 and 23 is/are rejected.
- 7) ☒ Claim(s) 3 and 6-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 1-27 are pending.

#### *Election*

2. It is noted that from the specification page 20 paragraph 30, that the NMR is for peloruside A, thus claim 13 will be examined with the elected invention.
3. Claim 23 has structures similar to those of claims 1-12. Thus, claim 23 will be examined with the elected invention.
4. Applicants are correct, claims 15,16 should be included with group I. Claims 15, 16 will be examined with group I.
5. Applicant's election without traverse of group I, claims 1-12,14-17,24-27 in the reply filed on October 11, 2005 is acknowledged. Claims 13 and 23 will also be examined.
6. Claims 18-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2005.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,2,4,5,13-17,23 are rejected under 35 U.S.C. 102(b) as being anticipated by West et al, Peloruside A: A Potent Cytotoxic Macrolides Isolated from the New Zealand Marine Sponge Mycale sp., J. Org. Chem., 2000, 65,445-449.

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9. Claims 1,2,4,5,13-17,23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0193423 that t discloses the isolation of Peloruside A of the structure shown at p. 5. col. 2 from a marine sponge. It also discloses the compounds where one or more of the five hydroxy groups of this compound have been converted to an alkoxy or acyloxy moiety.

*For above paragraphs 7 and 8, claims 1 and 2 claim synthetic Peloruside A. This does not patentably distinguish from the compound isolated from a natural source.*

For claim 4,5,13,23 the variables are such that peloruside A is encompassed. The alkoxy and acyloxy derivatives are commonly known to have similar pharmaceutical properties to the compounds containing the free hydroxy groups.

For claims 14-17, peloruside A is has anticancer activity. See West @ page 447 column 2 last paragraph, for example.

10. Claims 3,6-12,24-27 are not included in the above rejections as the references neither teach nor suggest the claimed species or synthetic process for making peloruside derivatives.

#### ***Claim Objections***

11. Claims 3,6-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Allowable Subject Matter***

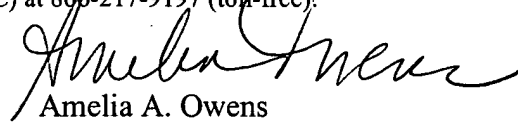
12. Claims 24-27 are allowed. The prior art neither teaches nor suggests the claimed synthetic process for preparing peloruside A derivatives. In the absence of any evidence or apparent reason why the claimed compounds do not possess the disclosed utility, the allegation of utility in the specification must be accepted as correct. In re Kamal et al, 158 USPQ 320; Ex parte Krenzer, 199 USPQ 227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amelia A. Owens  
Primary Examiner  
Art Unit 1625